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OFFICE OF PETITIONS

In re Application of :  
Reed et al. :  
Application No. 10/036,882 : ON PETITION  
Filed: 2 January, 2002 :  
Att'y Docket No. 79377 :

This is a decision on the petition under 37 CFR 1.137(a),<sup>1</sup> filed on 16 July, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Renewed Petition under 37 CFR 1.137(b)." This is not a final agency decision.

This application became abandoned on 20 March, 2004, for failure to timely submit a reply to the non-final Office action mailed on

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<sup>1</sup>A grantable petition under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed; In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(1);

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

19 December, 2003, which set a three (3) month shortened statutory period for reply. No extensions of time under 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 29 June, 2004.

Petitioner asserts unavoidable delay in filing a timely reply because of a docketing error. Specifically, petitioners state that the attorney previously working on this application left counsel's employ and the docketing system failed to identify the case as being assigned to that attorney. The application was therefore not reassigned to a new attorney. Additionally, the application file was inadvertently marked as abandoned by the clerical staff after the abandoned parent file was placed the present application's file.

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to be "unavoidable".<sup>2</sup> Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.<sup>3</sup>

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<sup>2</sup>35 U.S.C. § 133.

<sup>3</sup>In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314,

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).<sup>4</sup> Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.<sup>5</sup>

Turning to petitioner's assertion of docketing error, a delay resulting from an error (e.g. a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

(1) the error was the cause of the delay at issue;

(2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(3) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.<sup>6</sup>

An adequate showing requires:

(i) Statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them.

(ii) Petitioner must supply a thorough explanation of the docketing call-up system in use and identify the type of records kept and the person responsible for the maintenance of the system. This showing must include copies of mail ledger, docket sheets, filewrappers and such other records as may exist which

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316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

<sup>4</sup>See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

<sup>5</sup>Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

<sup>6</sup>See MPEP 711.03(c)(III)(C)(2).

would substantiate an error in docketing, and include an indication as to why the system failed to provide adequate notice that a reply was due.

(iii) Petitioner must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

The petition lacks the showing required by items (1), (2), and (3) above.

First, petitioners have not discussed the mechanics of the docketing system, or how cases are assigned to attorneys and the attorney assignment recorded in the docketing system. Furthermore, counsel has not explained why this application was not indicated in the docketing system as being assigned to the former attorney. Was the case marked as assigned to a different attorney, or to no attorney at all? Petitioners should provide statements or declarations of facts by all persons with direct knowledge of, and responsibility for, the docketing processes describing in detail how patent applications are docketed and why this patent was not docketed to the former attorney.

Furthermore, petitioners have not adequately explained why the application file was marked as abandoned when in fact petitioners did not intend for it to be abandoned. Petitioners should explain why this was done, what counsel's normal business practice was, and why that practice failed in this instance. Furthermore, a statement from the employee who marked this file as abandoned explaining why it was so marked should be provided.

Additionally, petitioners have not provided copies of mail ledger, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed to provide adequate notice that a reply was due.

Lastly, petitioners must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks. Petitioners' bare assertion that the docketing system was reliable and the employees sufficiently trained does not constitute a proper showing of unavoidable delay.

In summary, the showing of record is that the delay occurred as a result of multiple mishaps on the part of petitioners. First, petitioners' failed to properly record in the docketing system the attorney to whom this application was assigned, so that it was not reassigned when that attorney left petitioners' employment. Second, the application file was inadvertently and inexplicably marked "abandoned" when the parent file was placed in the present application's file. Third, counsel's clerical staff did not inform any attorneys upon the receipt of the Office action mailed on 19 December, 2003, but rather simply placed the Office action in counsel's files, because they believed counsel was no longer prosecuting this application.

In summary, the showing of record is that the delay in taking action in the above-identified application was result of a lack of diligence rather than unavoidable delay. As the showing of record does not rise to the level of unavoidable delay, the petition will be dismissed.

#### **ALTERNATIVE VENUE**

Petitioners may wish to consider filing a renewed petition under 37 CFR 1.137(b), which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after 8 June, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

A copy of the form for filing a petition under 37 CFR 1.137(b) to revive an application unintentionally abandoned is enclosed herewith for petitioner's convenience.

Further correspondence with respect to this matter should be addressed as follows:

By mail:           Mail Stop Petition  
                  Commissioner for Patents  
                  P.O. Box 1450  
                  Alexandria, VA 22313-1450

By FAX:           (703) 872-9306  
                  Attn: Office of Petitions

By hand:           U.S. Patent and Trademark Office  
                  220 20<sup>th</sup> Street S.  
                  Customer Window, Mail Stop Petition  
                  Crystal Plaza 2, Lobby, Room 1B03  
                  Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the undersigned at (703)308-6918.



Douglas I. Wood  
Senior Petitions Attorney  
Office of Petitions

Enclosure:       Form PTO/SB/64  
                  Privacy Act Statement